

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated June 2, 2005 (hereinafter Office Action) have been considered. Claims 1-43 remain pending in the application. The Applicants first note the allowance of Claims 15-28, and thank the Examiner for favorable consideration of these claims. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Claim 9 stands rejected under 35 U.S.C. §112, second paragraph. The Office Action states that it is unclear how a remote session endpoint can issue a session termination message after receiving a release notification because “each of the network entities will terminate the communication session after receiving the session release notification.” Applicants respectfully traverse the rejection. “Unless the steps of a method actually recite an order, the steps are not ordinarily construed to require one. However, such a result can ensue when the method steps implicitly require that they be performed in the order written.” *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 59 USPQ2d 1401 (Fed.Cir.2001). Applicants note that the nothing in Claim 9, nor in Claims 1 and 8 from which Claim 9 depends, expressly restricts the order in which the method steps are to be carried out. Therefore nothing in Claim 9 prevents the issuance of a session termination message before the network entities terminate the communication session. Nonetheless, in order to further prosecution of the application, Applicants have amended Claim 9 to set forth that the session termination message is issued at the remote session endpoint before terminating the communication session at the remote session endpoint. In light of this amendment, Applicants respectfully suggest withdrawal of the rejection of Claim 9.

Claims 1-14, 29-38, and 40 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2004/0008669 to Bos et al. (hereinafter *Bos*). The Applicants respectfully traverse in view of the amendments and remarks provided herein.

The Applicants respectfully submit that Claim 1-14, 29-38, and 40 as originally filed are not anticipated by *Bos*. However, in order to facilitate prosecution of the application, the Applicants present this response with amendment to clarify particular aspects of the

aspects of the claimed invention. As amended, Claim 1 at least sets forth the subscription by one or more network entities to one or more intermediary network entities that provide call session control. The intermediary network entities serve as notifiers. A session release notification is initiated via a signaling protocol from a first notifier to its respective subscriber, and the session release notification is logically advanced towards a remote one of the session endpoints via the intermediary network entities. As to Claims 29, 33, 38, and 40, these claims have been amended to more particularly set forth that a determination as to whether a session should be released is made independently by call session control elements of these claims.

The *Bos* reference describes a system for providing alternate circuit switched connections to improve the reliability of SIP sessions. According to the Office Action, with respect to Claim 1, *Bos* teaches an intermediary network element by way of server "D" in FIG. 2 and paragraphs 0066 and 0071. The Office Action also alleges that *Bos* teaches subscribing the network entities as subscribers to intermediary network entities serving as notifiers in FIG. 2 and paragraph 0066. Applicants respectfully disagree with these characterizations of *Bos* and the Applicants' invention, and submit that *Bos* does not disclose at least these elements of Claim 1.

To anticipate a claim, a single prior art reference must expressly or inherently teach every element as set forth in the claim. The identical invention must be shown in as complete detail as is contained in the patent claim; *i.e.* every element of the claimed invention must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). However, server D of *Bos* is not a network entity that provides call session control as set forth in Claim 1, nor does *Bos* describe network entities that subscribe to intermediary network entities that are serving as notifiers.

Paragraph 0050 of *Bos* describes a server 2 that is an application server in combination with a P-CSCF and S-CSCF. In the description of FIG. 2, the SIP BYE originates at the application server D, and not at the P-CSCF B or S-CSCF C (*Bos*, paragraph 0098). The function of the application server D is to establish a circuit switched data link between endpoints to supplement a packet-switched SIP call. The application

server of *Bos* is not meant to handle call session control, because *Bos* shows separate P-CSCF and S-CSCF that performs these functions. *Bos* does not teach expressly or inherently that P-CSCF or S-CSCF are serving as notifiers, nor that any of the network entities subscribe to these CSCFs for session release notifications. *Bos* is deficient in at least teaching this aspect of Claim 1.

Regarding to independent Claims 29, 33, 38, and 40, the Office Action does not allege that *Bos* teaches a release recognition module operable with the processor to determine whether a session should be released at a call session control entity, stating that it is “inherent; according to the IETF specification all CSCFs have the ability to release a session.” Applicants respectfully submit that the Examiner has not met the burden of proof required to show inherency, and therefore the rejection of Claims 29, 33, 38, and 40 under §102 cannot be maintained.

Although extrinsic evidence, in certain circumstances, can be used to fill in “gaps” in the primary reference when such reference is silent about an asserted inherent characteristic, such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Moreover, such extrinsic evidence may be used to explain, but not expand, the meaning of terms and phrases used in the reference relied upon as anticipatory of the claimed subject matter. MPEP § 2131.01

Applicant respectfully asserts that the Examiner is inappropriately applying the doctrine of inherency available under 35 U.S.C. § 102(b). Applicants do not acquiesce to the assertion that “all CSCFs have the ability to release a session.” Yet even if this were true, it is not clear that one skilled in the art would recognize this. This rather broad statement ascribes a specific capability to all instances of a particular network element, and in a complex system such as a CSCF, such an assertion would require a more precise definition of the alleged inherent capability and where such capabilities are described. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*,

17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Examiner has relied on “the IETF specification” to prove this inherency, but the Applicants note that IETF is an organization that oversees an enormous and diverse repository of standards, specifications, and technical documents. Therefore, a statement that some characteristic is taught in the IETF, without more particular guidance, is too conclusory to show that such characteristic is inherent. Thus, Applicants respectfully request that the Examiner produce the requisite extrinsic evidence that would render these particularized elements of Applicants’ claimed invention inherent in view of *Bos* or withdraw the presently maintained anticipation rejection of Claims 29, 33, 38, and 40.

In addition, the Applicants note that the Examiner uses the “ability to release a session” that is allegedly inherent in *Bos* in order to show that *Bos* teaches “determining whether a session should be released” as set forth in Claims 29, 33, 38, and 40. These are two distinct capabilities, and to equate the two is tantamount to expanding the meaning of the terms and phrases allegedly inherent in *Bos*, which is improper under MPEP § 2131.01. Thus for this additional reason, the Applicants submit that Claims 29, 33, 38, and 40 are allowable over *Bos*.

Claims 41-43 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2004/0203710 to Gabor et al. (hereinafter *Gabor*). The Applicants respectfully traverse in view of the amendments and remarks provided herein. The Applicants respectfully submit that Claims 41-43 as originally filed are not anticipated by *Gabor*. However, in order to facilitate prosecution of the application, the Applicants present this response with amendment to clarify particular aspects of the claimed invention.

Gabor is directed to a method for preventing a called party from being charged based on a call establishment attempt which has failed (*Gabor*, Abstract). Paragraph 39 of *Gabor* describes how called party 102 will send a BYE message if ACK signal from the calling party is not received. The CSCF takes into account the unsuccessful call attempt in charging information, which is sent with the failed attempt information to a charging node.

In one point of contrast, Claim 41 sets forth that the CSCF determines whether a dialog that is already established over an IMS by should be released. *Gabor* does not teach this feature, because *Gabor* only shows determining that the attempted establishment of a session has been unsuccessful. (*see, e.g., Gabor*, paragraph 0039 of). Therefore, *Gabor* does not teach software instructions that independently determine whether an established session should be released at the CSCF, because *Gabor* is only related to unsuccessful establishment requests, and does not even deal with releasing established sessions via a call session control element.

In addition, the Office Action has not shown where *Gabor* discloses accepting a subscription to a session release notification from a User Equipment (UE) as set forth in Claim 41. Again, the Examiner has relied upon inherency, stating that this is “inherent in 5’3.” However, the only descriptions of this step is in paragraph 0041, which states that this step is the same as step S3, which is described in paragraph 0036 as the sending of an INVITE message to the party being called. Applicants submit that one skilled in the art would not find that accepting a subscription to a session release notification is inherent in forwarding an INVITE message; these are two independent and unrelated transactions. Because the Examiner did not provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of *Gabor*, Applicants respectfully submit that this element is not inherent in *Gabor*, and thus Claim 41 is allowable over *Gabor*.

Dependent Claims 2-14 depend from independent Claim 1; dependent Claims 30-32 depend from independent Claim 29; and dependent Claims 34-37 depend from independent Claim 33. These dependent claims also stand rejected under 35 U.S.C. §102(e) as being anticipated by *Bos*. Dependent Claims 42-43 depend from independent Claim 41 and stand rejected under 35 U.S.C. §102(e) as being anticipated by *Gabor*. While Applicant does not acquiesce with the particular rejections to these dependent claims, these rejections are now moot in view of the remarks made in connection with independent Claims 1, 29, 33, and 41. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims

from the references relied upon in the rejections. Therefore, dependent Claims 2-14, 30-32, 34-37 and 42-42 are also in condition for allowance

Claim 39 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Bos* in view of *Gabor*. Applicants respectfully traverse the rejection. It is respectfully submitted that a *prima facie* case of obviousness has not been established. To establish *prima facie* obviousness based on a combination of references, three basic criteria must be met, as is set forth in M.P.E.P., §2143:

- 1) There must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) There must be a reasonable expectation of success; and
- 3) The prior art references must teach or suggest all of the claim limitations.

As set forth in greater detail below, the Applicants contend that *prima facie* obviousness has not been established, for reasons including the failure of the prior art references (either alone or in combination) to teach or suggest all of the claim limitations, and that a legally requisite motivation to combine such references has not been established.

In the Office Action, *Bos* was applied to the subject matter of Claim 38 from which Claim 39 depends, and has applied *Gabor* to the recited features of dependent Claim 39. Therefore, the Examiner argues that *Bos* by itself teaches or suggests all of the claimed recitations of independent Claim 38. As set forth above, *Bos* fails to teach or suggest all the limitations of independent Claim 38, and therefore a combination of *Bos* and *Gabor* cannot teach or suggest dependent Claims 39, as a combination of the references still fails to teach at least that which is set forth in independent Claim 38. For at least this reason, Claim 39 is not taught or suggested by a combination of *Bos* and *Gabor*, and Claim 39 is in condition for allowance.

Further, respectfully submitted that the Examiner's stated motivation to combine *Bos* and *Gabor* fails to meet the standard for establishing *prima facie* obviousness. The Examiner's stated motivation to combine the references is "to insure the termination of the session." It is respectfully submitted that this does not provide a motivation to combine

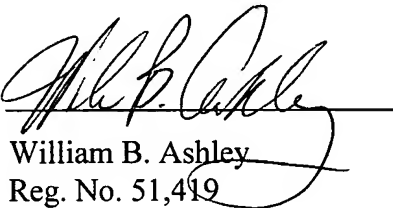
the references, but rather uses the Applicants' disclosure as a blueprint for piecing together the prior art to defeat patentability. For this additional reason, it is respectfully submitted that *prima facie* obviousness has not been established for the 35 U.S.C. §103(a) rejection to dependent Claim 39.

Authorization is given to charge Deposit Account No. 50-3581 (NOKM.064PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact him at 952-854-2700 (x12) to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700

Date: 12/2/2005

By: 
William B. Ashley
Reg. No. 51,419